

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re )  
Petitioner )  
\_\_\_\_\_ )

Decision on Petition  
under 37 C.F.R. § 10.2(c)

**MEMORANDUM AND ORDER**

("Petitioner") requests review under 37 C.F.R. § 10.2(c) of a decision of the Director of Enrollment and Discipline ("Director"), entered August 22, 1997, refusing to give Petitioner a passing grade on the afternoon section of the patent practitioner's examination for registration held on August 28, 1996. The petition is denied.

**SUMMARY**

The Director's decision was on a request, under 37 C.F.R. § 10.7(c), for regrade of the afternoon section (claims drafting) of the patent practitioner's examination. Petitioner scored fifty-eight (58) points on this portion of the examination. The Director, in her August 22, 1997, decision, agreed with some of Petitioner's arguments and added six (6) points to Petitioner's score, thereby raising it to sixty-four (64) points, which is still six (6) points short of a passing grade of seventy (70). This review of the Director's decision, under 37 C.F.R. § 10.2(c), has resulted in no additional points being awarded to Petitioner.

**FACTS**

The claims drafting portion of the examination required Petitioner to draft four (4) claims to a champagne bottle cork puller: a single independent claim and three dependent claims. Claim

1 was for the broadest claim which defined the invention completely as set forth in the “Objects of the Invention” portion of the specification found at page 9 of the examination booklet. Claim 2 was for a dependent claim that covered all elements and sub-elements of the raising and lowering device integrated into the cork puller. Claim 3 was for a multiple dependent claim that covered: (a) a specific resilient material of which the body is composed; (b) the specific element that provides the shell with a reinforced structure; and (c) the specific element which adjustably mounts the raising and lowering device. Claim 4 was for a dependent claim that covered all features that defined the handle.

The prior art disclosed a stirrup-shaped cork puller with a slidably-mounted, screw-actuated pair of hooks used to grip a cork sealing a champagne bottle. The main part of this cork puller is a stirrup-shaped body made of indeterminate material. A raising and lowering device is attached to a cork engager which is itself comprised of a pair of adjacent slanting faces forming a set of jaws that can be moved in tandem to grip or release a cork.

At issue are Petitioner’s claims 1, 2, and 4 which are set forth verbatim below:

Claim 1: We claim

A champagne cork puller and inserting apparatus comprising;

- a body forming a semi-cylindrical shaped shell having an upper end, a lower end, and a longitudinal slot
  - the lower end having a bifurcated base,
  - the bifurcated base having on its inner surface an annular groove adapted to frictionally fit around the spout rim of a champagne bottle;
- a raising and lowering device having an upper end and a lower end adjustably mounted in the upper end of the body;

a pin;  
a cork engager rotatably mounted on the  
lower end of the raising and lowering device  
having  
    a head portion from which depends a  
    semi-cylindrical shaped wall defining  
    a lateral opening and a base opening  
the lateral opening able to receive a  
bulbous portion of a champagne cork  
and  
the base opening able to receive a  
stem portion of a champagne cork  
the head portion connected  
to the pin which is slidably movable  
within the longitudinal slot to prevent rotation of the cork  
engager while in use; and  
a handle affixed to the upper end of the  
raising and lowering device.

Claim 2:

A champagne cork puller and inserting apparatus according to claim 1 wherein the  
  
    raising and lowering device is an externally  
    threaded screw having an upper end and  
    a lower end,  
        the upper end having an internally  
        threaded axial bore in screw  
wherein the handle is affixed, and  
the lower end having an internally threaded  
axial bore in screw wherein the cork engager  
is rotatably mounted such that the cork engager  
is raised and lowered by turning the handle.

Claim 4:

A champagne cork puller and inserting  
apparatus according to any of claims 1 or 2  
  
    wherein the handle is an elongated member  
    having an upper surface,  
    an axial cavity, a pair  
    of levers extending equal distance

transversely of the axial cavity, a recess formed between the axial cavity and each of the levers, and a coaxial recess with the axial cavity of the upper surface of the handle adapted to receive a head of a bolt.

## **DECISION**

Petitioner disputes specific deductions made by the Director. Each of these deductions and Petitioner's specific arguments are addressed below.

### **A. Claim 1**

#### **1. "Single piece" not claimed**

Three points were originally deducted based on Petitioner's failure to include the limitation "single piece" to describe the "body" of the cork puller in claim 1. No additional points were awarded during the regrade. Petitioner argues that including the term "single piece" would be an unnecessary limitation of the claim.

In the instructions, Petitioner is advised to draft the broadest possible claim which defines the invention "as set forth in the Objects of the Invention . . . ." It is clearly set forth as one of the "Objects of the Invention" to provide a "single piece body" which functions to deflect spray from the user. Therefore, Petitioner's argument is unpersuasive, and the three point deduction for failing to claim a "single piece body" is appropriate. No additional points are warranted.

#### **2. "Resilient material" not claimed**

Three points were originally deducted based on Petitioner's failure to include the limitation "resilient material" to describe the "body." No additional points were awarded during the regrade. Petitioner argues that he "deliberately omitted the unnecessary limitation" of

“resilient material” because one of ordinary skill in the art would know to use “resilient material” to prevent chipping of the champagne bottle.

In the instructions, Petitioner is advised to draft the broadest possible claim which defines the invention “as set forth in the Objects of the Invention . . . .” It is clearly set forth as one of the “Objects of the Invention” to make the body of a “resilient material” which will avoid chipping the bottle during use of the cork puller. Therefore, Petitioner’s argument is unpersuasive, and the three point deduction for failing to claim “resilient material” is appropriate. No additional points are warranted.

3. “Slightly smaller” not claimed

One point was originally deducted based on Petitioner’s omission of the limitation “slightly smaller than a champagne bottle spout rim” to describe the annular groove. No additional point was awarded during the regrade. Petitioner argues that he used analogous language to claim this particular design feature. Specifically, Petitioner alleges that “an annular groove adapted to frictionally fit AROUND the spout rim of a champagne bottle” is equivalent to “an annular groove which is slightly smaller than the spout rim.” (Emphasis in the original.) Petitioner’s argument is unpersuasive.

As set forth above, the instructions required the Petitioner to draft the broadest possible claim which defines the invention “as set forth in the Objects of the Invention.” It is clearly set forth as one of the “Objects of the Invention” to provide the body of the apparatus with a “annular groove which is smaller than the spout rim.” Thus, there is an unmistakable size or dimensional aspect to the limitation. Instead of claiming such a size or dimensional limitation, Petitioner instead uses functional language (“adapted to fit”). Therefore, Petitioner’s argument is

unpersuasive, and the one point deduction for failing to claim “an annular groove which is slightly smaller than the spout rim” is appropriate. No additional point is warranted.

4. “A head portion” is an unnecessary limitation

Two points were originally deducted based on Petitioner’s claiming of an unnecessary limitation, to wit, “a head portion” of the cork engager. No additional points were awarded during the regrade. Petitioner argues that the prior art discloses a cork engager and that the invention includes a distinctively shaped cork engager which distinguishes it over the prior art, namely, that it includes “a head portion” and a “semi-cylindrical shaped wall.” A close reading of the specification reveals that the “semi-cylindrical shaped wall” serves to deflect spray away from the user (which was properly claimed by Petitioner), but that the “head portion” is not a similar attribute of the invention. Claiming the “head portion,” therefore, unnecessarily narrows the scope of the claim. The two point deduction was proper, and no additional points are warranted.

5. Shape of the base opening of the body not properly claimed

One point was originally deducted based on Petitioner’s omission of the limitation “base opening large enough to receive a stem portion of a bottle cork but not the bulbous portion.” No additional point was awarded during the regrade. Petitioner argues that he used analogous language to claim this particular design feature. Specifically, Petitioner alleges that “the base opening ABLE TO RECEIVE a stem portion of a champagne cork” is equivalent to the referenced language. (Emphasis in the original). Petitioner’s argument is unpersuasive.

As set forth above, the instructions required Petitioner to draft the broadest possible claim which defines the invention “as set forth in the Objects of the Invention.” On page 10 of the examination booklet, lines 16-21, the specification reads:

It is critical that lateral opening 74 be large enough to receive the bulbous portion 64 of cork 63 and that base opening 76 be large enough to receive the stem portion 65 of cork 63, but not large enough to receive the bulbous portion 64 of cork 63.

Thus, the proper limitation is the relative size of the opening compared to other structure.

Petitioner failed to make that comparison in the language that he used. Therefore, Petitioner's argument is unpersuasive, and the one point deduction is appropriate.

B. Claim 2

A total of eight points were deducted from Claim 2 based on Petitioner's failure to claim the handle attaching bolt and the cork engager attaching bolt. No points were restored during the regrade.

The examination directions required that Claim 2 "must cover all those elements and sub-elements which make up the raising and lowering device." (Emphasis in original). The raising and lowering device is described in the examination booklet at page 10, lines 22-25 wherein it states:

Raising and lowering device 80 is made up of an externally threaded screw 81, a handle 82, and **bolts 87 and 89**. Bolt 87 fixedly attaches handle 82 . . . . Bolt 89 rotatably mounts cork engager 70 to a lower end of screw 81 . . . .

(Emphasis added). Petitioner's claim does not include any recitation of the attachment bolts *per se*. Rather, Petitioner argues that his claim language "incorporates the use of a bolt . . . but does not limit the scope of the claim to use of ONLY bolts." (Emphasis in original). A close review of the claim language used by Petitioner, however, reveals that there is no claim limitation recited wherein the attachment bolts, or analogous structure, is set forth. Petitioner's argument, therefore, is unpersuasive. No additional points are warranted.

C. Claim 4

Two points were deducted for Petitioner's use of vague and indefinite language in describing the features which define the handle. No points were restored during the regrade. Claim 4 required Petitioner to write a dependent claim that included "all those features which further define the handle." The "handle" is described at page 12, lines 2-4 in the examination booklet:

Fig. 6 depicts handle 82 as an elongated member with a pair of levers 83 extending an equal distance transversely of an axial cavity 85 and defining the ends of handle 82.

Petitioner set forth a claim with the "handle" being an "elongated member having an upper surface, an axial cavity, a pair of levers extending an equal distance transversely at the axial cavity, a recess formed between the axial cavity . . . ." Petitioner does not set forth that the levers form the ends of the handle. Petitioner argues, in effect, that one of ordinary skill in the art would understand that the ends of levers would inherently define the ends of the handle. The examination instructions, however, caution that the examinee "may not rely on the Doctrine of Inherency for any reason, whether to support language having no antecedent basis or otherwise." (Emphasis in original.) Thus, the restoration of additional points for claim 4 is not warranted.



## CONCLUSION

Petitioner's request for additional points is denied. Petitioner's score remains at sixty-four (64), which is below the minimum passing score of seventy (70) for the afternoon portion of the examination.



Q. TODD DICKINSON

Deputy Assistant Secretary of Commerce and  
Deputy Commissioner of Patents and Trademarks

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